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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,473	01/15/2002	Jason Meyer	76867/20091	6158

23380 7590 03/25/2004

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EXAMINER	
MARKS, CHRISTINA M	

ART UNIT	PAPER NUMBER
3713	4

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/050,473	MEYER, JASON	
	Examiner	Art Unit	
	C. Marks	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 January 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 2.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the 1) secondary symbol substituting for a primary symbol in response to a trigger and 2) method for operating the gaming machine must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 12 and those dependent therefrom, the word "means" is preceded by no modifier thus serving as an empty means clause and is an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the empty clause preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). For example, what means are adapted to display. Is

there a processor means that is adapted to display an array by controlling the display, or is there a display means that does it. The structure of the invention cannot be inferred and thus the claim is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir et al. (US Patent No. 6,644,664) in view of Stone (US Publication No. 2003/0008698).

Muir et al. disclose a gaming machine comprising a display of an array of symbols randomly selected from a set of symbols (FIG 4). The machine is also adapted to pay winnings on the occurrence of predetermined winning combinations (Column 3, lines 8-10). The symbols are associated with a subset of secondary symbols (FIG 4, reference3s 44 and 46). Winnings can be paid on any of the primary or secondary symbols (Column 4, lines 15-20). Muir et al. discloses that a trigger can be established that allows a bonus condition and causes the blocks to open (Column 2, lines 13-16). However, Muir et al. does not disclose that the secondary symbols can substitute for the primary symbols in response to a trigger.

Stone discloses a gaming device wherein when a trigger occurs, the symbols will be substituted for other symbols in their respective areas (FIG 3). Stone discloses such a feature of substitution is advantageous because it effectively provides the player with a greater opportunity of winning the game (paragraph 7) as well as increases the player's interest in gamine by rewarding the player by adjusting an outcome into a winning outcome based upon a trigger (paragraph 8).

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Stone into the system of Muir et al. One would be motivated to modify Muir et al. to allow secondary symbol to replace a primary symbol on the basis of a trigger based upon the suggestion of Stone that doing so effectively provides the player with a greater opportunity of winning and increases their interest.

Regarding claim 2, Muir et al. displays primary and secondary symbols on a simulated three-dimensional object within the array. In applying Stone, the object would be moved in order to make the substitutions based on the trigger.

Regarding claim 3, the object of Muir et al. is a rectangle with the primary symbol on the front face and the secondary symbol on another face.

Regarding claim 4, the secondary symbol in Muir et al. is visible but it is clear that it is not part of the main array.

Regarding claims 5 and 15, Muir et al. shoes a plurality of prisms vertically stacked into at least two columns.

Regarding claims 6-9 and 15, the prisms are cubes and the trigger may cause any number of them to rotate based upon the current condition of the board, as disclosed by Stone. Stone supports any number rotating based upon whatever result is to be achieved and in

application to Muir et al., such a method would translate to the cubes being rotated in any number.

Regarding claim 10-11, both Muir et al. and Stone disclose a trigger condition causes a supplementary action and both dictate this condition to be predetermined combinations displayed.

Regarding claim 13, the combination of Muir et al. and Stone pays for winning combinations achieved both initially and as the result of the substitutions.

Regarding claim 14, the objects of Muir et al. are cubes and applying Stone would cause them to rotate to bring different symbols into the array.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Muir et al. (US Patent No. 6,644,664) in view of Stone (US Publication No. 2003/0008698) further in view of Smyth et al. (US 4,790,537).

What Muir et al. and Stone disclose, teach, and/or suggest has been discussed above and is incorporated herein.

The combination of Muir et al. and Stone does not teach of an oversized symbol.

Smyth et al. disclose a trigger that is a predetermined combination of two adjacent symbols wherein the combination is graphically represented in the array as a single symbol of greater size than the individual symbols (FIG 6). This symbol can be used as a substitute by rotating the reel (FIG 10).

It would have been obvious to one of ordinary skill in the art to incorporate such a feature into the combination of Muir et al. and Stone as an alternate means to display a winning outcome. One would be motivated to do so as disclosed by Smyth et al. in that the provision of symbols of different sizes around the periphery of the machine reel allows the use of large

indicate for larger payouts, thereby making it easier for the player to recognize those symbols (Column 1, lines 39-43). As the triggering occurs in both with an award, the larger symbol would be ideal for presenting such.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,251,013: Slot machine that upon trigger will alter the contents of one or more spaces on the display.

US Patent No. 4,790,537: Gaming machine with a nudge feature that will replace a previous symbol with another symbol to help user achieve greater success.

US Patent No. 6,089,977: Slot machine with a wild card that moves to different positions thus altering the symbols based on a triggering combination.

US Publication No. 2004/0009803: Gaming machine with special symbols that can be analyzed in many ways.

US Patent No. 6,270,411: Gaming machine wherein the results can be altered by an animation portion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa J Walberg can be reached on (703)-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cmm
March 18, 2004

MICHAEL O'NEILL
PRIMARY EXAMINER